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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,393	09/23/2003	Jon Godston	010398-9065-02	2524

7590 12/27/2004

Michael Best & Friedrich LLP  
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Milwaukee, WI 53202-4108

EXAMINER
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ALIE, GHASSEM

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/668,393

Applicant(s)

GODSTON ET AL.

Examiner

Ghassem Alie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to a punch for punching a workpiece including a four-bar linkage and at least two punch elements, classified in class 83, subclass 627.
  - II. Claims 8-13, drawn to a punch for punching at least one sheet of paper including a base, a support member having an arcuate portion, and at least one punch mechanism, classified in class 83, subclass 582.
  - III. Claims 14-21, drawn to a punch for punching a workpiece including a four-bar linkage including at least four members and a first linkage which operates at least a punch element by imparting a camming action upon the at least one punch element, class 83, subclass 618.
  - IV. Claims 22-29, drawn to a punch for punching a workpiece including a four-bar linkage, a base, an actuating portion, and at least four pivots defining therebetween a quadrilateral having at least two opposed, non-parallel sides, classified in class 83, subclass, 629.
  - V. Claims 30-39, drawn to a punch including a support member pivotally coupled to a base, a paper tray, and a drive member pivotally coupled to the base, classified in class 83, subclass 613.
  - VI. Claims 40-43, drawn to a method of punching a hole in a sheet of paper, classified in class 83, subclass 13.

The inventions are distinct, each from the other because:

2. Inventions VI and I-V are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the

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apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case (1) the process as claimed can be practiced by another materially different apparatus that does not have a four-bar linkage, a base, or a support member having an arcuate portion or pivotally coupled to a base.

3. Inventions of Groups I-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. Example 1, the invention of Group I having a four-bar linkages and at least two punch elements has a separate utility such as it could be used without a base, an arcuate portion for the support member, or at least one punch mechanism of Group II; conversely; the invention of Group II having a base, an arcuate portion for the support member, or at least one punch mechanism has a separate utility such as it could be used without the four-bar linkages and at least two punch elements of Group I. See MPEP § 806.05(d).

Example 2, the invention of Group III having a four bar linkage including at least four members and a first linkage which operates at least a punch element by imparting a camming action upon the at least one punch element and at least one punch element has a separate utility such as it could be used without the four-bar linkages a base, an actuating portion, and at least four pivots defining therebetween a quadrilateral having at least two opposed, non-parallel sides of Group VI; conversely, the invention of Group IV including a four-bar linkages a base, an actuating portion, and at least four pivots defining therebetween a quadrilateral having at least two opposed, non-parallel sides has a separate utility such as it could be used without the four bar linkage including at least four members a first linkage

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which operates at least a punch element by imparting a camming action upon the at least one punch element and at least one punch element of Group III. See MPEP § 806.05(d).

3. Upon election of <sup>one of</sup> the inventions I-V above, applicant is required to further elect one of the following species A-F as set forth below.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A. (Figs. 1-9) and support member receiving the workpiece at an upright angle less than 40 degrees from a vertical;

Species B. (Figs. 1-9) and support member receiving the workpiece at an upright angle less than 25 degrees from a vertical;

Species C. (Figs. 10) and support member receiving the workpiece at an upright angle less than 40 degrees from a vertical;

Species D. (Figs. 10) and support member receiving the workpiece at an upright angle less than 25 degrees from a vertical;

Species E. (Figs. 11-14) and support member receiving the workpiece at an upright angle less than 40 degrees from a vertical; and

Species F. (Figs. 11-14) and support member receiving the workpiece at an upright angle less than 25 degrees from a vertical.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR. 1.143).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501.

The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).



GA/ga

December 21, 2004

Allan N. Shoap  
Supervisory Patent Examiner  
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